

**REMARKS**

Claims 1-3, 5-15, 17-28, 63-76, 85 and 86 are pending and under consideration. Claims 1, 15, 24-28, 63, 64 and 85 have each been amended to correct a punctuation error and to incorporate the limitation of each preamble into the body of the claim. Claim 9 has been amended to clarify the claim scope. Entry of the amendments, which do not add any new matter, is respectfully requested. Entry of the proposed amendments is respectfully submitted to be proper because the amendments are believed to place the claims in condition for allowance.

**Regarding 35 U.S.C. § 102 (b)**

The rejection of claims 8, 23 and 70 under 35 U.S.C. §102(b) as being anticipated by Gordon et al (U. S. Patent No. 4,758,429) is respectfully traversed.

When lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1349, 48 U.S.P.Q.2d 1225, (Fed. Cir. 1998) (quoting *Shearing v. Iolab Corp.*, 975 F.2d 1541, 1544-45, 24 U.S.P.Q.2d 1133, 1136 (Fed. Cir. 1992)). To establish a *prima facie* case of anticipation, the Office must show that the single reference cited as anticipatory art describes all the elements of the claimed invention.

The Examiner alleges that, absent evidence to the contrary, it is assumed that the cell types recited in claims 8, 23 and 70 are found in synovial tissue. Current Office Action mailed May 5, 2009, pages 2-3. Applicants respectfully point out that it is inconsequential whether or not the cell types recited in claims 8, 23 and 70 are found in synovial tissue because claims 8, 23 and 70 each depend on a base claim that is limited to gastrointestinal and lung tissue. Applicants further point out that the Examiner had withdrawn the instant rejection over Gordon et al. in view of Applicants' amendments of the base claims to remove recitation of "synovium." As a matter of patent practice rules, it is impossible for a reference to anticipate a dependent claim without anticipating the corresponding base claim. This is because dependent claims further limit the subject matter of their corresponding base claims. Since neither gastrointestinal nor lung tissue contain synovium and claims 8, 23 and 70 are limited to lung and gastrointestinal

tissue, Gordon et al. does not anticipate claims 8, 23 and 70. Accordingly, Applicants request removal of the rejection of claims 8, 23 and 70 under 35 U.S.C. §102(b) as being anticipated by Gordon et al (U. S. Patent No. 4,758,429).

**Regarding 35 U.S.C. § 112, Second Paragraph**

Applicants respectfully traverse the rejection of claim 9 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicants submit that, when viewed in light of the specification, claim 9 sufficiently clear and definite to the skilled person to comply with the second paragraph of section 112 of the Code. Nevertheless, Applicants have amended claim 9 to clarify the claim scope, thereby addressing and rendering moot the instant rejection. Accordingly, Applicants respectfully request removal of the rejection of claim 9 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

**Regarding 35 U.S.C. § 102 (a or e)**

The rejection of claims 1-3, 5-15, 17-28, 63-76, 85 and 86 under 35 U.S.C. §102 (a or e) as being anticipated by Ganz (U. S. Patent No. 6,491,618) is respectfully traversed.

The invention is directed, *inter alia*, to a method for accelerating the cell cycle of a cell that is part of a gastrointestinal tissue or lung tissue by delivering to a cell an effective amount of electromagnetic energy to accelerate the cell cycle of said cell at least 2 fold.

The Examiner alleges that since Ganz disclose a method that comprises delivering electromagnetic radiation into a body cavity of a patient. According to the Examiner, absent evidence to the contrary, the skilled artisan would expect that the Ganz method would further function to accelerate the cell cycle. Office Action mailed May 4, 2009, at section 21, page 6. Furthermore, it is alleged that the various limitations “accelerating the cell cycle, activating a cell cycle regulator, activating a signal cell transduction protein, activating a transcription factor, a DNA synthesis protein, a receptor and inhibiting an angiotensin receptor are each recited in the

claim preamble only and, as a result, will not be afforded any patentable weight. Office Action mailed May 4, 2009, at section 22, pages 6-7.

For the reasons explained below, Applicants respectfully submit that the amendments to claims 1, 15, 24-28, 63, 64 and 85, which now recite in the body of each claim the limitations set forth in each preamble, renders this rejection moot.

A reference is anticipatory when it satisfies particular requirements. First, the reference must disclose each and every element of the claimed invention, whether it does so explicitly or inherently. *Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.*, 471 F.3d 1369, 1375 (Fed. Cir. 2006). The elements must be "arranged or combined in the same way as in the claim," *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1370 (Fed. Cir. 2008). Second, the reference must "enable one of ordinary skill in the art to make the invention without undue experimentation." *Impax Labs., Inc. v. Aventis Pharms. Inc.*, 545 F.3d 1312, 1314 (Fed. Cir. 2008); see *In re LeGrice*, 301 F.2d 929, 940-44 (CCPA 1962).

Under the principles of inherency, only if the prior art *necessarily* functions in accordance with, or includes, the claims limitations, it anticipates. *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999). The Federal Circuit held that a prior art method patent did not inherently anticipate the claims to a polymorph based on a finding that none of the methods disclosed in the prior art patent *invariably* yielded crystals of the claimed polymorph, but instead could yield crystals of either crystalline form. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 34 U.S.P.Q.2D (BNA) 1565 (Fed. Cir. 1995).

Applying the principles summarized above to the claims compels a conclusion that Ganz does not anticipate the rejected claims. Here, there is no indication that the method of Ganz, which is aimed at inducing apoptosis in a prokaryotic cell, would *necessarily* achieve the various limitations recited in claims 1, 15, 24-28, 63, 64 and 85. Accordingly, the Ganz does not inherently disclose the claimed methods. In addition, Ganz does not enable the claimed methods, which are targeted to produce effects including cell growth and replication in eukaryotic cells. Again, Ganz is directed at achieving apoptotic cell death in prokaryotic cells. Ganz provides no enabling teaching to the skilled artisan of how to practice the claimed methods. Overall, Ganz neither discloses nor enables the claimed methods of amended claims 1, 15, 24-28,

63, 64 and 85. Without disclosing and enabling the claimed methods, Ganz cannot support the instant anticipation rejection.

In view of the amendments and accompanying remarks, Applicants respectfully request removal of the rejection of claims 1-3, 5-15, 17-28, 63-76, 85 and 86 under 35 U.S.C. §102 (a or a) as anticipated by Ganz (U. S. Patent No. 6,491,618).

### **CONCLUSION**

In light of the amendments and remarks herein, Applicants submit that the claims are now in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to call the undersigned attorney if there are any questions.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

/Astrid R. Spain/

Astrid R. Spain  
Registration No. 47,956

11682 El Camino Real, Suite 400  
San Diego, CA 92130  
Phone: 858.720.3300 ARS:cjh  
Facsimile: 858.720.7800  
**Date: November 3, 2009**

**Please recognize our Customer No. 41552  
as our correspondence address.**